

**REMARKS**

This responds to the Office Action mailed on December 16, 2005, and the references cited therewith.

Claims 1-48 are now pending in this application.

**Drawing Objections**

The drawings were objected to under 37 C.F.R. 1.83(a) for not showing every feature of the invention specified in the claims.

Responsive to the rejection in paragraph 3 of the Office Action the Figures 3A, 3B, and 4 (e.g., blocks 105, 110, 115) show the claimed feature (e.g., claims 1, 12, 23, 34), “wherein said selected language construct is a predetermined question that is asked by said first entity and translated responsive to said selection by said first entity. For example, the Figure 3A shows a language construct, “WHAT IS YOUR ADDRESS” (e.g., predetermined question) that is shown to be associated with a CONSTRUCT ID 62 (e.g., 0001). The Figure 4, block 105 shows “SELECT CONSTRUCT AND SECOND USER ID” by a first user 92 (e.g., asked by first entity). The Figure 4, block 115 shows “PERFORM CONSTRUCT TRANSLATION” that is performed in response to the first user selecting the construct (e.g., translated responsive to said selection by first entity). Finally, the Figure 3B shows a stored translated language constructs table that shows a single CONSTRUCT ID 72 (e.g., 0001) that corresponds to multiple LANGUAGE IDs 74 (e.g., FR, IT, ES) that respectively correspond to multiple TRANSLATED CONSTRUCTS 76 in the respective languages.

Responsive to the rejection in the paragraph 4 of the Office Action, the amended Figure 6, block 615 and Figure 3A shows the claimed feature (e.g., claims 5, 16, 27, 38) “said predetermined question is asked by said first entity in an electronic commerce transaction over said network.” For example, the Figure 6, block 615 shows “RECEIVE SELECTED LANGUAGE CONSTRUCT (E.G., PREDETERMINED QUESTION) AND SECOND USER IDENTIFIER FROM THE FIRST USER (E.G., ELECTRONIC COMMERCE TRANSACTION). Further, the Figure 3A shows a language construct, “WHAT IS YOUR ADDRESS” (e.g., predetermined question), as described above. Support for the amendment to Figure 6 may be found in the claims 5, 16, 27 and 28 of the application as originally filed,

paragraphs 24-26, paragraphs 17-23 and in Figures 3A and 3B. Applicant submits no new matter has been added to the application.

Responsive to the rejection in the paragraph 5 of the Office Action, the Figures 3A, 3B, and 4 (e.g., blocks 105, 110, 115) show the claimed feature (e.g., claim 45), “said predetermined question is translated responsive to said selection of said first entity by retrieving said translated language construct from a table that includes a plurality of translated language constructs of said predetermined question that are respectively translated into different languages.” For example, the Figures 3A, 3B, and 4 (e.g., blocks 105, 110, and 115) show the claimed feature as described above.

Responsive to the rejection in the paragraph 6 of the Office Action, the Figure 4 at blocks 120, 125 and 130 and the added Figure 8 show the claimed feature (e.g., claim 46), “the second transmission includes a plurality of interactive fields to allow said second entity to respond to said predetermined question that is asked by said first entity.” For example, the block 120 shows, “GENERATE TRANSLATED MESSAGE”, the block 125 shows, “TRANSMIT TRANSLATED MESSAGE”, and the block 130 shows “SELECT FURTHER CONSTRUCT AND FIRST USER ID.” The Figure 8 shows an e-mail message 122, interactive fields 123, 124, and a drop-down list 126 that may contain multiple predetermined language constructs translated in the language preference of the second user 94 to allow the second user 94 to respond to the first user 92. Support for Figure 8 may be found in claims 2, 13, 24, and 35 as originally filed, paragraphs 31, 33, and 52 and Figures 3A, 3B, 4 and 6. Applicant submits no new matter has been added to the application.

Responsive to the rejection in the paragraph 7 of the Office Action, the Figure 4 at blocks 120, 125 and 130 and the added Figure 8 show the claimed feature (e.g., claim 47) “said plurality of interactive fields includes a first interactive field, wherein said first interactive field includes a drop down list that contains a plurality of predetermined language constructs that respectively respond to said predetermined question and are respectively translated into a second language based on a language preference of said second entity.” The Figure 8 shows an e-mail message 122, interactive fields 123, 124, and a drop-down list 126 that may contain multiple predetermined language constructs translated in the language preference of the second user 94 to allow the second user 94 to respond to the first user 92. Support for Figure 8 may be found in

claims 2, 13, 24, and 35 as originally filed, paragraphs 31, 33, and 52 and Figures 3A, 3B, 4 and 6. Applicant submits no new matter has been added to the application.

Responsive to the rejection in the paragraph 8 of the Office Action, the Figure 4, block 135 and the newly added Figure 9 show the claimed feature (e.g., claim 48) “receiving a reply message from said second entity that includes a selection of the said second entity from said first interactive field, said selection of the second entity including a response from said second entity to said predetermined question that is asked by said first entity.” For example, the Figure 4, block 135 shows, “TRANSMIT FURTHER CONSTRUCT IN A REPLY MESSAGE” and the Figure 9 shows a reply message 136 including a language construct 137 to respond to the translated language construct (WHAT IS YOUR ADDRESS?) from the first user 92. Support for the Figure 8 may be found in claims 2, 13, 24, and 35 as originally filed, paragraphs 32-34, 45, 53-54 and Figures 4 and 6. Applicant submits no new matter has been added to the application.

#### §112 Rejection of the Claims

Claims 1-48 were rejected under 35 U.S.C. § 112, first paragraph, as lacking adequate description. Specifically, the Office Action alleges the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

“The test for sufficiency of support in a parent application was whether the disclosure of the application relied upon ‘reasonably conveys to the artisan the inventor had possession at that time of the later claimed subject matter.’”

MPEP 2163.02, first paragraph, citing *Ralston Purina Co. v. Far-Mar-Co., Inc.*, USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).

“A description as filed is presumed to be adequate, unless or until sufficient evidence of reasoning to the contrary has been presented by the examiner to rebut the presumption.”

*In re Marzocchi*, 439, F.2d 220, 224, 169, USPQ 367, 370 (CCPA 1971).

The examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims.

*Wertheim*, 541 F.2d at 263, 191 USPQ at 97

Applicant respectfully submits the Office Action has failed to establish a *prima facie* case for rejecting claims 1-48 under 35 U.S.C. § 112, first paragraph, as lacking adequate description. Specifically, the Office Action fails to provide reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor, Steve Grove, was in possession of the invention as defined by the claims 1-48 in view of the disclosure of the present application as filed on October 11, 2001.

Claims 1, 5, 12, 16, 23, 27, 34, 38 and 45-48 were rejected under 35 U.S.C. § 112, first paragraph, as lacking adequate description. Specifically, the Office Action alleges the mentioned claims recite “predetermined question” and there is no disclosure of a “predetermined question” in the specification.

Applicant respectfully submits that claims 1, 5, 12, 16, 23, 27, 34, 38 and 45-48 should not be rejected under 35 U.S.C. § 112, first paragraph, as lacking adequate description for the reason that “predetermined question” is explicitly and implicitly disclosed in the original specification.

“In evaluating the sufficiency of the written description, terms need not be found in *haec verba*.” (in these words).

*Koito Mfg. Co. v. Turn-Key-Tech LLC*, 381 F.3d 1142, 72 USPQ2d 1190, 1199 (Fed. Cir. 2004)

“The subject matter of the claim need not be described literally (i.e., using the same terms of *in haec verba*) in order for the disclosure to satisfy the description requirement.”

MPEP 2163, Third Paragraph

“The claims as originally filed in the original specification are part of the disclosure and therefore, if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter.”

In re Benno, 768, F.2d 1340, 226 2SPQ

Applicant respectfully submits that “predetermined question” was explicitly disclosed in claims 5, 16, 27 and 28 of the application as originally filed and implicitly disclosed with the following quote:

“A stored construct table 60 stores a *predetermined number of language constructs, such as* sentences, phrases, *questions* or any other known types of language constructs.”

Application, Paragraph twenty-four.

Applicant submits that for the above stated reasons the present application conveys to the artisan that the inventor had possession, at the time of filing, of the subject matter of claims 1, 5, 12, 16, 23, 27, 34, 38 and 45-48.

The above remarks are applicable to a consideration of independent claims 1, 12, 23, and 24.

As dependent claims are deemed to include all limitation of claims from which they depend, the rejection of claims 5, 16, 27, 38 and 45-48 under 35 U.S.C. § 102(e) is also addressed by the above remarks, and the amendments contained herein.

Claims 1, 12, 23, 34 and 45-48 were rejected under 35 U.S.C. § 112, first paragraph, as lacking adequate description. Specifically, the Office Action requests the Applicant to point to the specification and drawings that support the newly added and amended claims.

Applicant respectfully submits that claims 1, 12, 23, 34 and 45-48 should not be rejected under 35 U.S.C. § 112, first paragraph, as lacking adequate description for the reason that the aforementioned claims are supported in the claims, written description and drawings as follows:

Claim(s)	Support from Original Claims	Support from Written Description (Paragraphs)	Support from Drawings
1, 12, 23, 24 (as amended)	5, 16, 27, 38,	24, 28-32, 39-43, 49-52	Figures: 3A, 4, 5, 6
45	3, 9, 10, 11,	24, 28-30, 39-42, 49-51	Figures: 3B, 4, 5, 6
46	2, 13, 24, 35,	31, 44, 52	Figures: 3A, 3B, 4, 6
47		28, 33, 40, 44	Figures: 3A, 3B, 4, 5
48	2, 13, 24, 35	32-34, 45, 53-54	Figures: 3A, 3B, 4, 6

§103 Rejection of the Claims

Claims 1, 3-5, 9-12, 14-16, 20-23, 25-27, 31-34, 36-38 and 42-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. 5,966,685 (hereinafter Flanagan).

Applicants respectfully submit that claims 1, 3-5, 9-12, 14-16, 20-23, 25-27, 31-34, 36-38 and 42-45 should not be rejected under 35 U.S.C. § 103(a) for the reason that prior art references when combined do not teach or suggest all of the claim limitations of the independent claims of the present application.

To establish a **prima facie** case of **obviousness**, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Claim 25 includes the following limitations:

communicating a plurality of predetermined language constructs to a first entity....

responsive to selection by said first entity of a language construct of said plurality of predetermined language constructs.....

....wherein said selected language construct is a predetermined question that is asked by said first entity and translated responsive to said selection by said first entity.

The Office Action alleges that the above limitation is taught or suggested by the following quotes from Flanagan:

FIG. 2 illustrates the message structuring of one embodiment of the present invention. Upon logging onto a discussion group, the user may choose his or her language preference. ... For example, a French user may log onto a discussion group and access the French version of the system.

Col. 4, lines 21-28.

The MT Model has three views that are each separate CompuServe discussion groups -- one in English (EMCIMSU) 58, one in French (FMCIMSU) 60, and one in German (DMCIMSU) 62. A user may only see one view at a time. All three discussion groups contain the same message content and configuration. In this Example, the following translation directions occur: English to French; English to German; French to English; and German to English.

In all three discussion groups, the message board section names appear in the native language. Messages in each section appear in the native language or are translated from another language. ... When a user posts a message on any one of the three discussion groups, the message translation process performs the translations and posts the translated messages onto the other two discussion groups. Messages translated from another language preferably contain the translation as well as the message as it originally appeared.

Col. 5, lines 45-64.

The above quotes from Flanagan describe a system which allows a user to communicate with other users who speak different languages (Abstract). The first quote describes a user who may log onto a discussion group and choose a language preference (e.g., French). The second quote describes the discussion groups or views. For example, the user may choose a language preference by selecting the English forum 58 (See Figure 4). The English forum is associated

with the following translations: English to French; English to German; French to English; and German to English. A user may see one view at a time. If a user posts a message on a discussion group, the message translation process translates and posts the message on the other two discussion groups. If a user receives a message from another discussion group the message preferably contains the translation and the original message (e.g., as it originally appeared).

Claim 1 requires a predetermined question that is asked by a first entity and translated responsive to the selection by the first entity. In contrast, the above two quotes from Flanagan do not describe a predetermined question that is asked by a first entity and translated responsive to the selection by the first entity; but rather, a selection of a language preference and a viewing of a discussion group that corresponds to the selected language preference. Clearly a language preference is not a predetermined question that is asked. The Office Action states:

Although Flanagan does not explicitly teach the use of a question, it is well known in the art and would be obvious to one of ordinary skill in the art that if a user is entering a chat and is required to enter information about what language the user would like information to be presented to them, it would be implied that the system is “asking a question” even though it is not stated in a propositional phrase (emphasis added).

Office Action, Section 18.

Applicant respectfully points out that claim 1 requires a predetermined question that is asked and selected. In other words if, as the Office Action alleges, the system is “asking a question” then the Office Action must also allege that Flanagan teaches or suggests the same system as selecting the question. Flanagan describes no such system. Indeed, Flanagan describes a system that enables the selection of a language preference and the viewing of a discussion group that corresponds to the selected language preference. Moreover significant differences exist between Flanagan and the present application. For example, the system described by Flanagan may be associated with drawbacks, as noted in the Background section of the present application:

Several attempts have been made to facilitate such communications [communication between users that utilize different written languages] and to provide translation software packages residing on a computer and configured to translate text or voice communications from one language to another. Some of these translation software

packages, however, can be expensive and can result in a financial burden for a user of such software packages. Furthermore, such software packages require considerable storage capacity to be available on the computer.

Another drawback of the translation software packages relates to their limited applicability. For example, current technology allows for translation of text through common text translation software installed on a computer. The translation may be accomplished in a variety of ways, one of which is direct word for word translation of the communication, which is imperfect and produces grammatically incorrect sentences in the translated language.

Present Application, paragraphs 2-4.

Flanagan therefore cannot be said to teach or suggest the above quoted limitations because Flanagan describes the selection a language preference and the viewing a discussion group that corresponds to the selected language preference and claim 1 requires a predetermined question that is asked and selected.

The above remarks are also applicable to a consideration of independent claims 1, 12, 23 and 34.

In addition, if an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 3-5, 9-11, 14-16, 20-22, 25-27, 31-33, 36-38 and 42-45 under 35 U.S.C. § 103 is also addressed by the above remarks.

Claims 2, 6, 7, 13, 17-18, 24, 28, 29, 35, 39, 40 and 46-48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Flanagan in view of U.S. 6,857,022 (hereinafter Scanlan).

Claims 2, 6, 7, and 46-48 depend on independent claim 1; claims 13 and 17-18 depend on independent claim 12; claim 24, 28 and 29 depend on independent claim 23; and, claim 35, 39 and 40 and depend on independent claim 34. If an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 2, 6, 7, 13, 17-18, 24, 28, 29, 35, 39, 40 and 46-48 under 35 U.S.C. § 103 is also addressed by the above remarks.

Claims 8, 19, 30 and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Flanagan in view of Christy U.S. 6,301,554 (hereinafter Christy).

Claim 8 depends on independent claim 1; claim 19 depends on independent claim 12; claim 30 depends on independent claim 23; and, claim 31 depends on independent claim 34. If

an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 8, 19, 30 and 41 under 35 U.S.C. § 103 is also addressed by the above remarks.

In summary, Flanagan in combination with Scanlan in combination with Christy does not teach or suggest each and every limitation of claims 1, 12, 23, and 34 as required to support rejections of the independent claims of the present application under 35 U.S.C. § 103.

### CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 408-278-4046 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 16 day of May, 2006.

Peter Rebuffoni  
Name

Peter Rebuffoni  
Signature

**IN THE DRAWINGS**

Corrected drawings are supplied herewith.

Enclosed is a Replacement Sheet showing the following amendment to Figure 6. The Figure 6, block 615 is amended to include “RECEIVE SELECTED LANGUAGE CONSTRUCT (E.G., PREDETERMINED QUESTION) AND SECOND USER IDENTIFIER FROM THE FIRST USER (E.G., ELECTROINIC COMMERCE TRANSACTION)”

Enclosed is a New Sheet for a Figure 8 illustrating an e-mail, according to one embodiment.

Enclosed is a New Sheet for a Figure 9 illustrating a reply message, according to one embodiment.

The above amendments are based entirely on written description in the pre-amendment specification and drawings, and accordingly do not add any matter to the drawings of the present application.